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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

|                           |  |
|---------------------------|--|
| Proceeding                | 91208511   |
| Party                     | Defendant<br>Sundek, LLC   |
| Correspondence<br>Address | BRIAN J DOWNEY<br>BARNES & THORNBURG LLP<br>41 S HIGH STREET, SUITE 3300<br>COLUMBUS, OH 43215<br>UNITED STATES<br>nhudson@btlaw.com; TMINDOCKET@btlaw.com, brian.downey@btlaw.com |
| Submission                | Motion to Amend/Amended Answer or Counterclaim   |
| Filer's Name              | Brian J. Downey  |
| Filer's e-mail            | brian.downey@btlaw.com   |
| Signature                 | /Brian J. Downey/  |
| Date                      | 04/15/2013   |
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| Bata Brands S.a.r.l. Luxembourg,<br>Succursale De Lausanne | :<br>:<br>:<br>:<br>:<br>:<br>:<br>:<br>:<br>:<br>: | Mark: SUNDEK           |
| v.   | :   | Opp. No.: 91208511     |
| Sundek, LLC  | :   | Serial No.: 85/569,536 |
| Applicant.   | :   |                        |

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**APPLICANT'S FIRST AMENDED ANSWER TO NOTICE OF OPPOSITION  
AND COUNTERCLAIM**

Pursuant to Federal Rule of Civil Procedure 15(a)(1)(B), Applicant, Sundek, LLC, ("Applicant") by and through its counsel, makes the following First Amended Answer to the Notice of Opposition and Counterclaim relating to the above captioned Opposition filed by Bata Brands S.a.r.l. Luxembourg, Succursale De Lausanne ("Opposer"):

**ANSWER**

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 1 of the Notice of Opposition.
2. Applicant admits the allegations contained in Paragraph 2 of the Notice of Opposition.
3. Applicant admits the allegations contained in Paragraph 3 of the Notice of Opposition.
4. Applicant admits the allegations contained in Paragraph 4 of the Notice of Opposition.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 5 of the Notice of Opposition, and therefore denies those allegations.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 6 of the Notice of Opposition, and therefore denies those allegations.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 7 of the Notice of Opposition, and therefore denies those allegations.

8. Applicant denies the allegations contained in Paragraph 8 of the Notice of Opposition.

9. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 9 of the Notice of Opposition, and therefore denies those allegations.

10. Applicant denies the allegations contained in Paragraph 10 of the Notice of Opposition.

11. Applicant denies the allegations contained in Paragraph 11 of the Notice of Opposition.

12. Applicant denies each and every other allegation set forth in the Notice of Opposition not specifically admitted to herein and specifically denies that Opposer is entitled to the prayed for relief.

**FIRST AFFIRMATIVE DEFENSE**

1. The Notice of Opposition fails to state a claim upon which relief can be granted.

**SECOND AFFIRMATIVE DEFENSE**

2. Opposer cannot demonstrate that they will suffer any harm from the registration of the Applicant's mark because the Applicant's mark has coexisted with Opposer's cited mark for decades without confusion.

**THIRD AFFIRMATIVE DEFENSE**

3. Applicant has priority of use of its mark over Opposer.

**FOURTH AFFIRMATIVE DEFENSE**

4. Opposer's claims are barred, in whole or in part, by the equitable doctrines of laches, acquiescence, waiver and/or estoppel.

**FIFTH AFFIRMATIVE DEFENSE**

5. The Opposition is barred under the prior registration (Morehouse) doctrine because Applicant owns U.S. Registration No. 984,566, a substantially similar mark for substantially similar goods.

WHEREFORE, Applicant prays for judgment against the Opposer, dismissing the Notice of Opposition in its entirety.

**COUNTERCLAIM**

Sundek, LLC believes that it is being damaged by Bata Brands S.a.r.l. Luxembourg, Succursale De Lausanne's ("Bata") Registration No. 975,546 for SANDAK for use on footwear (the "Registration"). Sundek, LLC hereby petitions to cancel the Registration pursuant to Section 14 of the Trademark Act of 1946 (15 U.S.C. §1064) and as grounds therefore, alleges:

1. In the 1940s, SUN-DEK of California, Applicant's predecessor (Applicant and its predecessors in interest, collectively, "Sundek"), began use of the SUN-DEK mark on swimwear.

2. Since the 1940s, prior to Opposer's adoption and registration of SANDAK, Sundek has been known by the name, and identity, "Sundek".

3. Indeed, to this day, Sundek and its licensees refer to Sundek as "Sundek" (*see* <http://www.shopsundek.com/en/history.php>).

4. In 1958, Sundek expanded its product offerings to include SUNDEK branded shorts specifically designed for surfing, making SUNDEK one of the first brands dedicated to the sport.

5. Throughout the 1960s, the SUNDEK brand expanded through the use of innovative solutions and designs for surf wear and swimming apparel.

6. During this same time period, the surfer lifestyle became popularized in U.S. culture through movies and music. Sundek both seized upon, and assisted, this growing popularity through its sponsorship of surfers and surfing contests. By putting the Sundek corporate name and mark behind these promotions and contests, SUNDEK became a household name for surf, swimming and beach apparel.

7. Further, SUNDEK branded goods became synonymous with Sundek as the identity of the company which was the source of those goods.

8. Given the popularity of Sundek and its association with the surfer lifestyle, anyone adopting a mark for use on flip-flops and other beach-type footwear during this time would have been aware of Sundek and its name.

9. During the 1960s, the extensive use of the SUNDEK brand reinforced Sundek's public identity, or "persona" in the eyes of consumers as "Sundek".

10. The 1972 introduction of Sundek's now iconic rainbow broadshorts, cemented the SUNDEK brand's longstanding fame and recognition and brought further attention and recognition to Sundek's identity, namely, "Sundek" as the source of those goods.

11. At the time the SUNDEK mark was adopted, and today, the word "Sundek" was, and is, part of the organizational name of Sundek and its predecessor.

12. Since Sundek's initial use of the SUNDEK mark, it has continuously used, promoted and offered SUNDEK branded apparel in the United States. Due to this long-standing, continuous use of the SUNDEK mark, Sundek enjoys tremendous goodwill in connection with the use of its SUNDEK mark on all kinds of apparel.

13. Further, the substantial and continuous use of the SUNDEK mark has cemented "Sundek" as the known identity of Sundek in the minds of consumers as they all associate SUNDEK branded goods with Sundek.

14. Bata has opposed Sundek's application for the SUNDEK mark for use on "clothing, namely, swimsuits, broadshorts, sweatshirts, knit shirts, t-shirts, tank tops, jackets, coats, dresses, dress shirt, pants, Capri pants, and shorts; footwear; headwear".

15. As grounds for its opposition, Bata has alleged that all of the goods in Sundek's opposed application are identical to, or related to, Bata's own goods sold under the mark covered by the Registration.

16. Upon information and belief, Bata uses its SANDAK mark on, among other types of footwear, flip-flops and other shoes that would be commonly worn at a beach.



17. Sundek has built up a significant reputation in the beachwear industry under its name and identity, "Sundek."

18. The Registration claims a date of first use September, 1961 with a date of first use in U.S. Commerce of June, 1970.

19. Sundek has, since prior to Bata's claimed date of first use, continuously used the SUNDEK mark in commerce and been known by the identity "Sundek".

20. Sundek is damaged by the continuance of the Registration because Bata has opposed Sundek's application under Section 2(d) of the Trademark Act, alleging that Sundek's mark is likely to cause confusion with the subject mark of the Registration.

21. Sundek is further damaged by the continuance of the Registration as consumers will assume a false association between Sundek and Opposer's goods under Section 2(a) of the Trademark Act.

22. The SANDAK mark is a close approximation of Sundek's identity, only differing by one letter.

23. Given the uniqueness and fame of the SUNDEK mark and Sundek's identity and reputation in the beachwear industry, SANDAK will be recognized as Sundek because it is such a close approximation to Sundek that it will point uniquely, and unmistakably, to Sundek.

24. Consumers seeing the SANDAK mark will recognize it to be Sundek's name and identity.

25. Purchasers seeing the SANDAK mark on flip-flops and other footwear will presume that those goods are connected with Sundek.

26. Sundek is not connected with, or otherwise associated with, Opposer or Opposer's goods bearing the SANDAK mark.

27. Given Sundek's priority of use of its name, mark and identity, Sundek prays that Registration No. 975,546 be cancelled under Trademark Act Section 2(a), 15 U.S.C. §1052(a), as falsely suggesting a connection with Sundek.

By reason of the foregoing, Sundek is, and will continue to be, damaged by Registration No. 975,546 and prays that the Registration be cancelled.

Respectfully submitted,



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Brian J. Downey  
Barnes & Thornburg LLP  
Suite 3300  
41 S. High Street  
Columbus, OH 43215  
Tel: (614) 628-1424  
Fax: (614) 628-1433  
[Brian.Downey@btlaw.com](mailto:Brian.Downey@btlaw.com)

*Attorney for Sundek, LLC*

Dated: April 15, 2013



**CERTIFICATE OF SERVICE**

I, Brian J. Downey, hereby certify that on April 15, 2013, I caused a true and correct copy of the foregoing Applicant's Answer to Notice of Opposition and Counterclaim be served upon Opposer's Attorney of Record via first class mail, postage pre-paid, at the following address:

John Clarke Holman  
Jacobson Holman PLLC  
400 7<sup>th</sup> St., NW  
Washington, DC 20004

  
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Brian J. Downey